IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

E & J Gallo Winery Opposer. vs. Cerveceria Centroamericana, S.A. Applicant.	Opposition No. 91155195 Application Serial No. 76/380,736

REPLY OF APPLICANT IN RELATION TO ITS MOTION FOR SUMMARY JUDGMENT WITH INCORPORATED LEGAL BRIEF

Cerveceria Centroamericana, S.A. ("Applicant") does hereby respectfully request the present reply be considered by the Trademark Trial and Appeal Board pursuant to Trademark Rule 2.127 (a). Although Opposer's Response to Applicant's Motion for Summary Judgment does not raise new issues, it does mischaracterize Applicant's position and arguments such that consideration of the present Reply is believed to be necessary and appropriate. In support thereof, Applicant states as follows:

1. **Opposer's purported dilution claim does not diminish Applicant's entitlement to summary judgment**. In Toro Co. v. ToroHead Inc., 61 USPQ 2d 1164 (TTAB 2001), the Board found that ToroMR and bulls head design for specialized magnetic heads did not dilute opposer's TORO mark used and registered for a variety of goods and services, including lawn mowers, tractors,

and trucks. The Board further noted therein that, to prove dilution, the defendant's mark must be identical to or substantially similar to plaintiff's mark. It is not enough that the marks are similar such as would be the case in an ordinary likelihood of confusion case. Applicant's position and exposition in its Motion for Summary Judgment show there is no genuine issue of material fact as to the disimilarity of the respective marks such that it is entitled to judgment as a matter of law. Applicant maintains its mark is neither identical, nor substantially similar to Opposer's mark. Accordingly, any possible dilution claim by Opposer must fail.

2. **Opposer cannot argue Applicant's Motion for Summary Judgment lacks probative evidence or legal basis because it previously conceded a motion on the disimilarity of the respective marks would be dispositive of this case and stipulated that discovery should be stayed.** Exhibit 6 to the Declaration of Paul Reidl, submitted in connection with Opposer's Response to Applicant's Summary Judgment Motion conclusively establishes that Opposer in effect requested Applicant to file its Motion for Summary Judgment and suggested that all discovery, including that previously served by Applicant be stayed. Opposer cannot now complain that discovery responses were not attached to Applicant's Motion. From the Declaration of Paul Reidl and Opposer's Memorandum of Points and Authorities in Response to Applicant's Motion for Partial Summary Judgment, it is clear Opposer understands that if the marks are dissimilar in sight, sound and meaning, this opposition and any corresponding discovery cannot further proceed. The remainder of Mr. Reidl's Declaration, as well as the Declaration of Gerry Glasgow, serve no purpose other than to repeat the insufficient allegations of the Notice of Opposition.

3. **Opposer incorrectly states Applicant's Summary Judgment Motion lacks a statement of material facts not genuinely in dispute**. Paragraphs 3 through 14 of Applicant's Summary Judgment Motion contain such statement. In fact, the headings corresponding to those paragraphs are entitled "Undisputed Facts Regarding Opposer's Trademarks" and "Undisputed Facts Regarding Applicant's Mark."

4. **Opposer does not dispute that although it pursued legal action to abate use of GALLO by Pasatiempos Gallo, S.A. it has not objected to use and registration of GALLITO by Pasatiempos Gallo, S.A. for the same goods.** US Trademark Registrations 1790389 and 1878728 for GALLITO with respect to playing cards and board games are held by Pasatiempos Gallo, S.A., the defendant in Opposer's cited case, E & J Gallo Winery v. Pasatiempos Gallo, S.A., 905 F. Supp. 1403 (E.D. Cal. 1994). While Opposer objected to Pasatiempos Gallo's use of GALLO on playing cards and board games, Opposer coexists with the same company's use and registration of GALLITO on the noted goods. Although at Page 8 of Opposer's Memorandum of Points and Authorities in Response to Applicant's Motion for Partial Summary Judgment, Opposer again mentions the noted reported case, it does not dispute the coexistence of its marks with GALLITO.

5. **Opposer incorrectly states Applicant position with respect to the *Dupont* factors**. Applicant's position is that a likelihood of confusion cannot be found because the respective marks are dissimilar in sight, sound and meaning, even if Opposer could establish at trial that the remaining

Dupont factors are satisfied in its favor. For the record and as more particularly expressed in Paragraph 15 of its Summary Judgment Motion, Applicant has stated the respective goods in this opposition are different, unrelated and the remaining *Dupont* factors, if considered at trial, would favor Applicant not Opposer. Summary judgment has been granted where, as here, there is a lack of any triable issue of fact on likelihood of confusion due to distinctly dissimilar marks. Riverhead Paints Plus, Inc. v. PPG Industries, Inc., 2 USPQ 2d 2035 (EDNY 1987); Nabisco, Inc. v. Warner-Lambert Co., 220 F. 3d 43, 55 USPQ 2d 1051 (2d Cir. 2000); Long John Distilleries, Ltd. v. Sazerac Co., Inc., 426 F.2d 1406, 166 USPQ 30 (CCPA 1970); Keebler Co. v. Murray Bakery Products, 9 USPQ 2d 1736 (Fed. Cir. 1989).

6. **Opposer is requesting the Board to apply the erroneous "per se" rule that because Opposer's and Applicant's goods are beverages they must be found to be related**. In In re August Storck KG, 218 USPQ 823 (TTAB 1983), it has been held there exists no "per se" rule that all food products are to be deemed related goods by nature or by virtue of their capability of being sold in the same markets, that is, modern supermarket environment with its enormous variety of food, cleaning, paper and other products stocked and offered for sale.

7. **Opposer does not abide by the standard it has cited that the test is not what the trademark means in the abstract, but what it means to consumers**. Although Opposer alleges one of the meanings of GALLO in Spanish and Italian is ROOSTER, nowhere in its Notice of

Opposition does Opposer allege what its trademark(s) mean to consumers. It has not stated whether consumers understand its mark to be in Italian or Spanish. Although Opposer alleges the GALLO surname has been heavily advertised and has acquired distinctiveness, it has not alleged what meaning its surname has acquired. Even though Opposer's mark has been heavily litigated, the reported litigations cited by Opposer are also silent on this issue. As demonstrated in Applicant's Summary Judgment Motion, whether or not the foreign equivalents rule is applied here, Opposer's and Applicant's marks differ greatly in sight, sound and meaning. Opposer has not stated what contradicting evidence, if any, it would or could rely on at trial with respect to Applicant's submissions on the sight, sound and meaning test.[1] On this basis, the Board must dismiss Opposer's Notice for failing to state a recognizable claim.

RELIEF REQUESTED

For the foregoing reasons, Applicant prays that the Notice of Opposition be denied and that the application herein opposed be allowed to proceed to registration.

Respectfully submitted,
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By: _____
Olga González, Esq.
Date: June 24, 2003

[1]It cannot be disputed that GALLO is a 5 letter, 2 syllable word and GALLITO is a seven letter, 3 syllable word which look differently and must necessarily be pronounced differently by virtue of these distinctions.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing REPLY OF APPLICANT IN RELATION TO ITS MOTION FOR SUMMARY JUDGMENT WITH INCORPORATED LEGAL BRIEF has been furnished by first class, postage prepaid mail to Paul W. Reidl, E & J Gallo Winery, Legal Department, 600 Yosemite Boulevard, Modesto, California 95354 this 24 day of June, 2003.

Olga González

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06-24-2003
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Commissioner of Trademarks
TTAB - No Fee
2900 Crystal Drive
Arlington, Virginia 22202

TRANSMITTAL

Attached hereto are the following items:

1. Reply of Applicant in Relation to its Motion for Summary Judgment With Incorporated Legal Brief. (Original and two copies.)

2.. Return Postcard to acknowledge your receipt of the foregoing items.

Applicant believes no payment of fees is required in connection with this filing. However, the Commissioner is hereby authorized to charge a deficiency to Deposit Account 07-1550.

Respectfully submitted,
OLGA GONZALEZ, P.A.
Applicant's Counsel

By: _____
Olga Gonzalez
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Date: June 24, 2003

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CERTIFICATE OF MAILING BY EXPRESS MAIL

Express Mail Mailing Label No. EK310928265US EK310928265US
Date of Deposit: June 24, 2003
I hereby certify that this paper of fee and its attachments are being deposited with the United States Postal Service "Express Mail Post Office To Addresee" service under 37 C.F.R. §1.10 on the date indicated above and is addressed to the Commissioner of Trademarks, TTAB, 2900 Crystal Drive, Arlington, Virginia 22202-3513

OLGA GONZALEZ
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Signature of person mailing paper or fee